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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,651	08/15/2001	Takayuki Narita	81868.0032	2848

26021 7590 04/03/2003

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EXAMINER

SICONOLFI, ROBERT

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,651

Applicant(s)

NARITA ET AL.

Examiner

Robert A Siconolfi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Amendment filed on 2/25/03 has been received.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The applicant has amended the claims to include a process step. Product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Therefore, the examiner is required only to show that the product is obvious. Please see MPEP 2113.

3. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukutani et al (U. S. Patent no. 5,998,898) in view of Brusic et al (U. S. Patent no. 5,316,573).

Fukutani et al discloses:

See figures shaft 12, copper sleeve/ cylindrical member 21 with bearing gaps containing lubricating fluid (see figure 2)

Fukutani et al does not disclose coating the copper cylindrical member with Cupric Benzotriazole. Brusic et al teaches coating copper members for corrosion protection

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(see column 2 lines 3-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the copper cylindrical member with Cupric Benzotriazole as taught by Brusic et al in the bearing of Fukutani et al in order to protect the device.

Regarding claim 4, the thickness of the antirust coating is a design choice based on wear, performance, and costs of the device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose any thickness of anti rust coating in order to optimize the bearing based on chosen design criteria.

4. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukutani, as modified, in view of Pavilon et al (U. S. Patent no. 5,308,521).

Fukutani, as modified, is relied upon as in rejection of claim one above. Fukutani, as modified, does not disclose adding benzotriazole into the lubrication fluid. Pavilon et al teaches adding benzotriazole into the lubrication fluid to protect copper bearing parts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add benzotriazole to the lubricating fluid as taught by Pavilon et al in the bearing of Fukutani, as modified, in order to further protect the bearing and thus increase durability.

Regarding claim 8, see column 2 lines 28-41

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NOTE: In order to expedite prosecution, since if a process can be shown to be critical and therefore receive patentable weight, the examiner makes the following parallel rejection which shows that the process claimed by the applicant is old and well known.

5. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukutani et al (U. S. Patent no. 5,998,898) in view of Hobbins et al (U. S. Patent no. 4,395,294).

Fukutani et al discloses:

See figures shaft 12, copper sleeve/ cylindrical member 21 with bearing gaps containing lubricating fluid (see figure 2)

Fukutani et al does not disclose coating the copper cylindrical member with Cupric Benzotriazole. Hobbins et al teaches coating copper members for corrosion protection by reacting the copper with benzotriazole (see column 2 lines 11-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the copper cylindrical member with Cupric Benzotriazole by reacting the copper with benzotriazole as taught by Hobbins et al in the bearing of Fukutani et al in order to protect the device.

Regarding claim 4, the thickness of the antirust coating is a design choice based on wear, performance, and costs of the device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose any thickness of anti rust coating in order to optimize the bearing based on chosen design criteria.

6. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukutani, as modified, in view of Pavilon et al (U. S. Patent no. 5,308,521).

Fukutani, as modified in view of Hobbins et al, is relied upon as in rejection of claim one above. Fukutani, as modified, does not disclose adding benzotriazole into the lubrication fluid. Pavilon et al teaches adding benzotriazole into the lubrication fluid to protect copper bearing parts. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add benzotriazole to the lubricating fluid as taught by Pavilon et al in the bearing of Fukutani, as modified, in order to further protect the bearing and thus increase durability.

Regarding claim 8, see column 2 lines 28-41

Response to Arguments

7. Applicant's arguments filed 2/25/03 have been fully considered but they are not persuasive. Applicant argues that the film is materially different since it allegedly is self-repairing and self-replacing. This is based on the fact that the copper cylindrical member will replace copper lost from the film. The examiner disagrees. The film of Brusic et al is being placed on a copper cylindrical member. Therefore, by the same reasoning that the applicant applies to the instant invention, the film of Brusic would be self-repairing and self-replacing.

Furthermore, as the examiner noted above, the process step added receives no patentable weight unless the process is proved to be critical. Lastly, the examiner has shown in another rejection that the process claimed is old and well known.

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8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A Siconolfi whose telephone number is (703) 305-0580. The examiner can normally be reached on M-F 10 am-3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on (703) 308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Robert A Siconolfi
Examiner
Art Unit 3683


JACK LAVINDER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

RS
March 27, 2003

3/28/03